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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,350	04/15/2004	Michael L. Fripp	2003-IP-009957 U2 USA	8640
49431	7590	10/31/2005		
KONNEKER & SMITH, P.C. 660 NORTH CENTRAL EXPRESSWAY SUITE 230 PLANO, TX 75074			EXAMINER WAKS, JOSEPH	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/825,350

Applicant(s)

FRIPP ET AL.

Examiner

Joseph Waks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) 16-31 and 89-114 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-59 and 65-68 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10, 14, 15, 32, 33, 36, 60, 62-64, 69, 72, 83, 87 is/are rejected.
- 7) ☒ Claim(s) 7, 9, 11-13, 34, 35, 61, 70, 71 and 73-82, 84-86, 88 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0905:0205:06.0704.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-88, drawn to a power generating system using vibrating assembly responding to fluid flow, classified in class 290, subclass 1R.
  - II. Claims 89-114, drawn to a power generating system using a beam that displaces in response to fluid flow and creating regions of different strain energy, classified in class 290, subclass 1R.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the beam structure that creates regions of different strain energy. The subcombination has separate utility such as microstructure for sensing device.
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I Figure 21

Species II Figure 23

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 30 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. During a telephone conversation with Marlin R. Smith on October 25, 2005 a provisional election was made with traverse to prosecute the invention of Group I, Species I, claims 1-15 and 32-88. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-31 and 89-114 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Specification***

7. The disclosure is objected to because of the following informalities: In page 1, line 19 the copending application serial Number is missing. Listing the docket number in the specification is inappropriate.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris (US 2,895,063).

Morris discloses invention as claimed: a vibrating assembly 13 or 23 which displaces in response to fluid flow across the vibrating assembly, and a generator 11, 12 which generates electrical power in response to displacement of the vibrating assembly, wherein the vibrating assembly includes a lift reversal device which produces alternating lift coefficients in the vibrating assembly in response to the fluid flow across the vibrating assembly.

10. Claims 1-4, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Apstein (US 3,663,845).

Apstein discloses invention as claimed: a vibrating assembly 54 which displaces in response to fluid flow across the vibrating assembly, and a generator 42, 28, 32 which generates electrical power in response to displacement of the vibrating assembly, wherein the vibrating assembly includes a lift reversal device which produces alternating lift coefficients in the vibrating assembly in response to the fluid flow across the vibrating assembly, the elastic support 56 and the ferromagnetic spacers 12, 14, 16 and 18.

11. Claims 1-3, 6, 10, 14, 15, 32, 33, 36, 60, 62-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Tubel et al. (US 5,839,508).

Tubel et al. disclose in Figure 3 invention as claimed: a vibrating assembly 72 which displaces in response to fluid flow across the vibrating assembly, and a generator 78 which generates electrical power in response to displacement of the vibrating assembly, wherein the vibrating assembly includes a lift reversal device which produces

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alternating lift coefficients in the vibrating assembly in response to the fluid flow across the vibrating assembly, magnet and coil, and wherein relative displacement between the magnet 72 and coil 78 produces electricity in the coil in response to displacement of the vibrating assembly.

12. Claims 1, 2, 4, 5, 69, 72, 83, 87 are rejected under 35 U.S.C. 102(b) as being anticipated by Kolm et al. (US 4,387,318).

Kolm et al. disclose invention as claimed: a vibrating assembly 16 which displaces in response to fluid flow across the vibrating assembly, and a generator 12 which generates electrical power in response to displacement of the vibrating assembly, wherein the vibrating assembly includes a lift reversal device which produces alternating lift coefficients in the vibrating assembly in response to the fluid flow across the vibrating assembly, an electromagnetically active material 14.

### ***Double Patenting***

13. Claims 32, 37, 42, 43, 60, 65, 69 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 14, 13, 12, 11, 10, 9, 5 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

14. Applicant is advised that should claims 13 and/or 12 or 11 or 9 be found allowable, claims 37, and/or 42 or 53 or 65 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates

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or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Allowable Subject Matter***

15. Claims 7, 9, 11-13, 34, 35, 61, 70, 71 and 73-82, 84-86, 88 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Claims 37-59, and 65-68 are allowed.

***Prior Art***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Waks whose telephone number is (571) 272-2037. The examiner can normally be reached on Monday through Thursday 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren E. Schuberg can be reached on (571) 272-2044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph Waks  
Primary Examiner  
Art Unit 2834

10/29/05